

## **REMARKS**

Claims 1, 2, 4, 5, 7, 15, 16, 18, 19, 21-31, 33-35, 49-57, 59-62, 64-67, and 69-70 are all the claims pending in the application. Claims 3, 17, 21, and 65 are cancelled above.

Applicant respectfully submits that entry of this amendment is proper because this amendment will either place the application in condition for allowance or in better form for appeal. Accordingly, no new issues are raised that necessitate a further search of art. Applicant respectfully traverses the rejections based on the following discussion.

### **I. The 35 U.S.C. ' 112, Second Paragraph, Rejection**

Claim 21 stands rejected under 35 U.S.C. §112, second paragraph. Claim 21 has been canceled, above, rendering this rejection moot. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **II. The Prior Art Rejections**

Claims 1, 2, 4, 5, 7, 15, 16, 18, 19, 21-31, 33, 35, 49-57, 59, 61-62, and 65-66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,932,270 to Fajkowski, hereinafter referred to as Fajkowski. Claims 10, 34, 47, 60, and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski in view of U.S. Publication No. 2002/10107738 to Beach et al., hereinafter referred to as Beach. Claims 1, 2, 4, 5, 7, 15, 16, 18, 19, 21-31, 33, 35, 49-57, 59, 61-62, and 65-66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski in view of U.S. Patent No. 4,446,528 to Marmon, hereinafter referred to as Marmon. Claims 34, 60, and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski in view of Beach. Applicants respectfully traverse these rejections based on the following discussion.

#### **A. The 35 U.S.C. 103(a) Rejection as Unpatentable over Fajkowski**

Applicants respectfully traversed this rejection because Fajkowski teaches a system and method that operates during and after the user is making a purchase with coupons, while the claimed invention provides the user with an optimized suggestion before the user makes the purchase.

More specifically, Fajkowski only checks whether the coupons are appropriate after the user has made a purchase. For example, item 161 in Figure 15a shows that the coupon submitted by the user is compared to the item previously purchased and, after this process, the system and method in Fajkowski check to see whether multiple coupons for the same item had been presented in item 163. If more than one coupon is submitted for a purchased item, the user is provided the option of selecting which coupon they desire to use for that item, as shown for example by items 162a-162e in Figure 15a. The details of this process are also discussed at length in column 17, lines 13-28 of Fajkowski.

To the contrary, all independent claims define that the claimed systems, methods, and computer program products make a suggestion of the most favorable combination of coupons that is based upon an optimization process before the user makes the purchase. The claimed invention specifically involves a situation where "two or more of said e-coupons can be used in combination within the same purchase." Further, the independent claims (independent claims 1, 15, 22, 49, and 62) somewhat similarly define that the systems, methods, and computer program products perform "an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items" to produce "a most favorable combination of coupons" and "before said user makes said purchase, outputting a suggestion to said user displaying said most favorable combination of coupons."

Therefore, Applicants submit that the claims define the situation where a user is presented with a very complex array of choices that involve multiple coupons per item purchased in that the claims define a manner of performing an optimization that maximizes the discount amount, the number of loyalty points, and the number of free items and, based upon this optimization process, presents the user with a suggestion as to what would be the most favorable combination of coupons for a purchase that the user is contemplating. The claimed invention allows the user to most beneficially plan their purchases, according to their individual needs, and operates well in advance of any actual purchase. This is fundamentally different than the teachings in Fajkowski which occurs at the point of sale or after the point of sale as shown by items 161 and 163 in Figure 15a, discussed above.

The Office Action argues (at the top of page 4) that it would have been obvious for the system in Fajkowski to have been modified to use a combination of coupons on a single purchased item; however such suggested modification is in direct contrast to the teaching of Fajkowski because (as explained in column 3, lines 1-36) one of the major purposes of the system proposed by Fajkowski is the elimination of coupon redemption fraud. In other words, Fajkowski teaches away from the proposed modification suggested in the Office Action. The system proposed by Fajkowski includes a specific measure (item 163 in Figure 15a) of preventing coupon fraud by not allowing customers to redeem more than one coupon for a given purchased item.

Applicants note that an obvious modification of the teachings of a reference must be based on an interpretation of the reference as a whole. In this situation, Applicants respectfully submit that Fajkowski would not have been modified as suggested in the Office Action because Fajkowski teaches away from such a modification where Fajkowski touts as one of its benefits, the ability to prevent fraudulent redemption of coupons.

Further, the first full paragraph for page 12 of the Office Action argues that the claimed invention merely automates what was a previously manual system. In response, because Fajkowski requires that multiple coupons cannot be used for a given item, the most that could be automated from the teachings of Fajkowski would be an automated system of checking whether duplicate coupons were being presented for the same item. To the contrary, the claimed invention relates to a very complicated decision-making system which might not be able to be performed manually principally because of the number of factors that must be considered, including how different combinations of coupons could be applied to a single item and, at the same time, maximizing the discount amount, the number of loyalty points, and the number of free items. Therefore, the claimed invention performs a number of steps that could not be performed manually and is more than just the automation of a previously known manual system.

Thus, as shown above, it is Applicants position that Fajkowski does not teach or suggest the claimed systems, methods, and computer program products that make a suggestion of the most favorable combination of coupons that is based upon an optimization process before the user makes the purchase. The claimed invention specifically involves a situation where "two or

more of said e-coupons can be used in combination within the same purchase." Further, the independent claims (independent claims 1, 15, 22, 49, and 62) define that the systems, methods, and computer program products perform "an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items" to produce "a most favorable combination of coupons" and that "before said user makes said purchase, outputting a suggestion to said user displaying said most favorable combination of coupons."

Therefore, it is Applicants' position that independent claims 1, 15, 22, 49, and 62 are patentable over Fajkowski. Further, dependent claims 2, 4, 5,, 7, 16, 18, 19, 23-31, 33-35, 50-57, 59-61, 64, 66-70 are similarly patentable, not only because they depend from a patentable independent claim, but also because of the additional features of the invention they define. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**B. The 35 U.S.C. 103(a) Rejection as Unpatentable over Fajkowski and Beach**

As shown above, it is Applicants position that Fajkowski does not teach or suggest the invention as defined by independent claims 1, 15, 22, 49, and 62 and the same arguments are not repeated here. Instead, the discussion here focuses principally upon the secondary reference, Beach. It is Applicants' position that Beach suffers from the same deficiencies with respect to the claimed invention as does Fajkowski. More specifically, Beach discloses a system where a user previously identifies coupons using a website (item 312, Figure 3) and then after the user makes purchases (item 314 in Figure 3) an agent causes the coupons to be redeemed and for the user's account to be credited for the coupon amounts (item 322 in Figure 3).

Therefore, it is Applicants' position that the teachings of Beach are limited to actions that occur at or after the user makes a purchase. In addition, the primary thrust of the teachings within Beach focus on eliminating the need for users to utilize paper coupons (paragraphs 0007, 0008) and therefore Beach does not elaborate regarding any advice given to the user as to what the best combination of coupons would be, other than to explain (in, for example, paragraph 0035) that coupons that relate to items which the consumer intends to purchase can be presented

to the user. In other words, Beach is principally directed to a paperless coupon system and therefore understandably does not contain extensive discussions of determining which combination of coupons would be the most favorable for a given user.

In view of the foregoing, it is Applicant's position that the proposed combination of Fajkowski and Beach would not have taught or suggested to one ordinarily skilled in the art the claimed systems, methods, and computer program products that make a suggestion of the most favorable combination of coupons based upon an optimization process before the user makes the purchase. The claimed invention specifically involves a situation where "two or more of said e-coupons can be used in combination within the same purchase." Further, the independent claims (independent claims 1, 15, 22, 49, and 62) somewhat similarly define that the systems, methods, and computer program products perform "an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items" to produce "a most favorable combination of coupons" and that "before said user makes said purchase, outputting a suggestion to said user displaying said most favorable combination of coupons."

Therefore, it is Applicants' position that independent claims 1, 15, 22, 49, and 62 are patentable over the proposed combination of Fajkowski and Beach. Further, dependent claims 2, 4, 5, 7, 16, 18, 19, 23-31, 33-35, 50-57, 59-61, 64, 66-70 are similarly patentable, not only because they depend from a patentable independent claim, but also because of the additional features of the invention they define. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **C. The 35 U.S.C. 103(a) Rejection as Unpatentable over Fajkowski and Marmon**

As shown above, it is Applicants position that Fajkowski does not teach or suggest the invention as defined by independent claims 1, 15, 22, 49, and 62, and the same arguments are not repeated here. Instead, the discussion here focuses principally upon the secondary reference, Marmon. It is Applicants' position that Marmon is limited to a device that allows a user to calculate whether they should use a coupon or not use a coupon and that Marmon does not

provide any guidance as to which would be the most favorable combination of coupons.

More specifically, as most clearly illustrated in the Abstract of Marmon, Marmon is directed to a device that performs a calculation as to whether it would be better to purchase one quantity of an item using a coupon or to purchase another quantity of an item without using a coupon. For example, the user can enter the price and quantity of an item with the application of a coupon and can also enter the price and quantity of an item without using a coupon to determine which action results in the lowest cost (column 3, line 32-45 of Marmon). Therefore, it is Applicants' position that Marmon is limited to teaching a process for determining whether or not coupons should be used and that Marmon is unrelated to the claimed systems, methods, and computer program products that make a suggestion of the most favorable combination of coupons based upon an optimization process before the user makes the purchase.

The claimed invention specifically involves a situation where "two or more of said e-coupons can be used in combination within the same purchase." Further, the independent claims (independent claims 1, 15, 22, 49, and 62) define that the systems, methods, and computer program products perform "an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items" to produce "a most favorable combination of coupons" and "before said user makes said purchase, outputting a suggestion to said user displaying said most favorable combination of coupons."

Therefore, it is Applicants' position that independent claims 1, 15, 22, 49, and 62 are patentable over the proposed combination of Fajkowski and Marmon. Further, dependent claims 2, 4, 5, 7, 16, 18, 19, 23-31, 33-35, 50-57, 59-61, 64, 66-70 are similarly patentable, not only because they depend from a patentable independent claim, but also because of the additional features of the invention they define. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **III. Formal Matters and Conclusion**

With respect to the objection of claim 65, claim 65 has been canceled rendering this objection moot.

In view of the foregoing, Applicants submit that claims 1, 2, 4, 5, 7, 15, 16, 18, 19, 21, 23-31, 33-35, 49-57, 59-62, 64, 66-67, and 69-70, all the claims presently pending in the application, are patentably distinct from the prior art of records and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest time possible.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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/Frederick W. Gibb, III/  
Frederick W. Gibb, III  
Registration No. 37,629

Gibb & Rahman, LLC  
2568-A Riva Road, Suite 304  
Annapolis, MD 21401  
Voice: (410) 573-1545  
Fax: (301) 261-8825  
Customer Number: 29154